

Appl. No. : 09/747,002  
Filed : December 22, 2000

### **REMARKS**

The following remarks are responsive to the September 13, 2005 Final Office Action. Claims 17-29 remain as previously presented. Thus, Claims 17-29 are presented for further consideration.

#### **Response to Rejection of Claims 17-29 Under 35 U.S.C. § 103(a)**

In the September 13, 2005 Final Office Action, the Examiner rejects Claims 17-29 under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent No. 6,134,384 issued to Okamoto et al. ("Okamoto") in view of U.S. Patent No. 6,792,000 issued to Morinaga et al. ("Morinaga").

#### **Claim 17**

The Examiner asserts that Okamoto discloses all the limitations of Claim 17, except for "storing [the] video data stream on a hard disk for efficient, non-sequential access to the stored stream of video data, the HDD having a plurality of sectors, each sector having a first integer of user data bytes." The Examiner further asserts that Morinaga discloses storing of "packets on a non-sequential access storage medium, hard disk," and that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the apparatus disclosed by Okamoto and to incorporate Morinaga's system of storing of transport packets onto a hard disk drive to achieve the teachings of the pending claims.

Applicant submits that there is no suggestion to combine the teachings of Okamoto and Morinaga to produce the method recited by Claim 17. Okamoto discloses a digital magnetic tape recording/reproducing system having a plurality of rotating heads which record/reproduce signals from the sectors of the magnetic tape. Okamoto at column 1, lines 20-60. Morinaga discloses a data processing apparatus which extracts packets to be recorded from a transport stream. Morinaga at column 1, lines 34-49. Morinaga further discloses that the packets can be stored on a hard disk drive. Morinaga at column 4, lines 37-42. Neither Okamoto nor Morinaga disclose any motivation to combine the hard disk drive of Morinaga with the method of recording and reproducing of digital signals on a magnetic tape taught by Okamoto to achieve the capabilities taught by Claim 17. Furthermore, there is no teaching or suggestion in the prior art that the method of recording and reproducing of digital signals on a magnetic tape taught by Okamoto would benefit in any way from the hard disk drive storage medium disclosed by Morinaga.

**Appl. No.** : **09/747,002**  
**Filed** : **December 22, 2000**

Therefore, there is no suggestion in the prior art to modify the method of Okamoto with the teachings of Morinaga.

Obviousness can only be established where there is some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988); M.P.E.P. Section 2143.01, page 2100-125, February 2003 revision. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See In re Mills, 916 F.2d 680 (Fed. Cir. 1990). To support the Examiner's assertion of obviousness, the Examiner must provide clear and particular findings as to the reason one skilled in the art, with no knowledge of the claimed invention, would have selected these components and combined them in the manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Without a teaching or suggestion in the prior art of the desirability of the combination, the Examiner's assertion that it would be obvious to one of ordinary skill in the art to incorporate the hard disk drive disclosed by Morinaga into the method disclosed by Okamoto is an impermissible use of hindsight derived from the teachings of the present application. See, e.g., In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

Applicant therefore submits that Claim 17 is patentably distinguished over the combination of Okamoto in view of Morinaga. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 17 and pass Claim 17 to allowance.

#### **Claims 18-25**

Each of Claims 18, 20, and 22-25 depends from Claim 17, Claim 19 depends from Claim 18, and Claim 21 depends from Claim 20. Thus, each of Claims 18-25 includes all the limitations of Claim 17, as well as other limitations of particular utility. For at least the reasons stated above with respect to Claim 17, Applicant respectfully submits that each of Claims 18-25 is patentably distinguished over the combination of Okamoto in view of Morinaga. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 18-25 and pass these claims to allowance.

Appl. No. : 09/747,002  
Filed : December 22, 2000

**Claim 26**

For at least the reasons stated above with respect to Claim 17, Applicant submits that the prior art does not provide a suggestion to combine the teachings of Okamoto and Morinaga. Therefore, Applicant submits that Claim 26 is patentably distinguished over the combination of Okamoto in view of Morinaga. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 26 and pass Claim 26 for allowance.

**Claims 27-29**

Each of Claims 27 and 28 depends from Claim 26 and Claim 29 depends from Claim 28. Thus, each of Claims 27-29 includes all the limitations of Claim 26, as well as other limitations of particular utility. For at least the reasons stated above with respect to Claim 26, Applicant respectfully submits that each of Claims 27-29 is patentably distinguished over the combination of Okamoto in view of Morinaga. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 27-29 and pass these claims to allowance.

**Summary**

For the reasons stated above, Applicant submits that Claims 17-29 are in condition for allowance, and Applicant respectfully requests such action.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10/21/05

By: 

Bruce S. Itchkawitz  
Registration No. 47,677  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404  
Attorney of Record

1968574  
102105